



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

m'

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,933	08/20/2001	Tom Sander	TB-1041A-US	1292

7590 02/18/2004

Donald J. Pochopien
MCANDREWS,HELD, & MALLOY, Ltd.
500 West Madison Street
Suite 3400
Chicago, IL 60661

EXAMINER

SNOW, BRUCE EDWARD

ART UNIT	PAPER NUMBER
----------	--------------

3738

29

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/701,933

Applicant(s)

SANDER ET AL.

Examiner

Bruce E Snow

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-61, 65, 66 and 69-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59-61, 65, 66 and 69-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Priority

Applicant priority is noted. The priority date for applicant's embodiment shown in figures 8A-8c is 8/27/97; the priority date for the embodiment shown in figures 8D-8F is 8/27/98.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 69 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 69 depends from cancelled claim 1 and is indefinite and, therefore, could not be rejection in view of the prior art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 59-61, 65-66, 70-71 are rejected under 35 U.S.C. 102(e) as being **anticipated** by Stroeve et al (5,728,159).

Referring to figure 2, Stroeve et al teaches a bone implant comprising a substantially planar upper and lower surfaces, an anterior end and a posterior end, a first side wall and second side wall opposite said first side wall, wherein the first and second side walls extend between the planar surfaces, and wherein the second side wall (indicated as P) comprises a concave surface and the first wall (A) comprises a convex surface. (Note that the implant also has side walls (L) and (M). Therefore, the implant has four side walls.) Regarding the term "elongate" used in the preamble, the term fails to breath life and meaning into the body of the claim and is given no patentable weight. On the other hand, giving weight to "elongate" the implant is "stretched out" between the L and M side walls and therefore is an "elongate bone implant".

Second rejection in view of Stroeve et al. Also see the embodiment shown in figure 1 having concave walls L and M. Regarding this embodiments, the term "elongate" used in the preamble fails to breath life and meaning into the body of the

claim and is given no patentable weight. On the other hand, giving weight to "elongate" the implant is "stretched out" between the L and M side walls and therefore is an "elongate bone implant".

Regarding claims 69-70, the embodiment shown in figure 1 would have the second side wall face inwardly.

Note that the grooves 18 and 20 produce ridges therebetween which prevent sliding the implant in any direction.

Claims 59-61, 65-66, 70-71 are rejected under 35 U.S.C. 102(e) as being **anticipated** by Pafford (6,371,988).

Referring to all figures specifically figures 25 and 28, Pafford teaches a bone implant comprising a substantially planar upper and lower surfaces, an anterior end and a posterior end, a first side wall and second side wall opposite said first side wall, wherein the first and second side walls extend between the planar surfaces, and wherein the second side wall comprises a concave surface (right side in figure 25) and the first wall (left side in figure 25) comprises a convex surface.

Referring to figure 25, clearly the implant is elongate in one direction.

Regarding claims 69-70, the concave side wall faces inwardly.

Claims 59-61, 65-66, 70-71 are rejected under 35 U.S.C. 102(e) as anticipated by Pafford et al (6,371,988) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pafford et al (6,371,988) in view of Kuntz (4,349,921).

Art Unit: 3738

102 rejection:

Referring to all figures, specifically figures 29-32, Pafford et al teaches a bone implant comprising a substantially planar upper and lower surfaces, an anterior end and a posterior end, a first side wall and second side wall opposite said first side wall, wherein the first and second side walls extend between the planar surfaces, and wherein the second side wall comprises a concave surface and the first wall comprises a convex surface. **Note the second side wall is interpreted an interior wall.**

Regarding the term "elongate" used in the preamble fails to breath life and meaning into the body of the claim and is given no patentable weight.

103 rejection:

Applicant is claiming the implant taught by Pafford et al, shown in figures 29-32, however is claiming only half of the implant. Kuntz teaches a spinal implant can be formed in a singular configuration, as shown in figures 1-4, or in two halves, as shown in figures 5-6. It would have been obvious to one having ordinary skill in the art to have used the teachings of Kuntz forming a spinal implant in two halves with any vertebrae prosthesis including that of Pafford et al because "*when a prosthesis for the lumbar area is required, it has been found advantages to make the prosthesis in two halves..*" see column 9, lines 41 et seq.

Also see MPEP2144.04, C. Making Separable.

Response to Arguments

Applicant's arguments filed 11/28/03, paper No. 25, (entered by paper No. 28) have been fully considered.

Applicant's argument that the Paul reference is not prior art to the embodiment shown in figures 8a-8c is persuasive.

Regarding the rejection under 35 U.S.C. 102(e) as being anticipated by Stroever et al this is not a 102(b) rejection.

The implant of Stroever et al is clearly not a circle and, therefore, the description of having a "diameter" is misleading. The implant is clearly elongate in one direction or another. Repeated from above:

Regarding the term "elongate" used in the preamble, the term fails to breath life and meaning into the body of the claim and is given no patentable weight. On the other hand, giving weight to "elongate" the implant is "stretched out" between the L and M side walls and therefore is an "elongate bone implant".

Also see the embodiment shown in figure 1 having concave walls L and M. Regarding this embodiments, the term "elongate" used in the preamble fails to breath life and meaning into the body of the claim and is given no patentable weight. On the other hand, giving weight to "elongate" the implant is "stretched out" between the L and M side walls and therefore is an "elongate bone implant".

Note that rejection under 35 U.S.C. 102(e) as being anticipated by Pafford (6,371,988) is not a 102(b) anticipated by WO98/17209. Pafford '988 has a priority date of Oct. 23 1996.

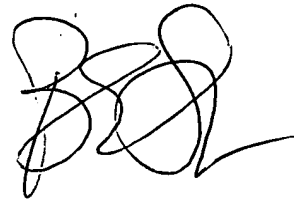
Applicant's arguments regarding the term "elongate" is believed to be adequately described in the grounds of rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E Snow whose telephone number is (703) 308-3255. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703)308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bes

A handwritten signature in black ink, appearing to read 'BSN', with a stylized flourish extending from the bottom right.

BRUCE SNOW
PRIMARY EXAMINER